

REMARKS/ARGUMENTS

Amendment

The claims are modified in the amendment. More specifically, claims 4, 12, 13, 19, 20 and 23 have been amended. Claims 3 and 14 have been cancelled. Therefore, claims 1-2, 4-13 and 15-24 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

Withdrawal of Finality of Present Office Action

In prior discussion with the Examiner regarding the Advisory Action, the Examiner indicated a new final Office Action would be issued. The Applicant had presumed the new final Office Action would have the same slightly-revised rejection that was presented in the Advisory Action for the first time.

The present Office Action is completely different and only has one reference in common with the prior office actions. Specifically, prior office actions relied upon U.S. Patent No. 5,959,874 to Lin et al., U.S. Patent No. 6,243,730 to Wang and U.S. Patent No. 5,831,885 to Mennemeier; but the present final Office Action relies on U.S. Patent No. 5,959,874 to Lin et al., non-patent literature document "8XC251SB Embedded Microcontroller User's Manual" of Intel Inc., U.S. Patent No. 3,993,891 to Beck et al. and U.S. Patent No. 6,141,675 to Slavenburg et al. Indeed, U.S. Patent No. 3,993,891 to Beck et al. appears for the first time with this final Office Action.

Additionally, new claim objections are presented that require correction. Final Office Action, page 2, section 2. Specifically, claims 12 and 23 are rejected. As this office action is a final action, it is not clear how the Applicant can present an amendment to correct these issues as there is no right to do so after a final office action.

For at least these reasons, Applicants believe the finality of this rejection is premature. As a matter of fairness, Applicants should have the ability to address new arguments

without being subject to all the restrictions a final office action imposes. Withdrawal of the final rejection is respectfully requested.

35 U.S.C. §103 Rejections

The Office Action has rejected claims 1-2, 4-7, 9-13, 15-16 and 18-22 under 35 U.S.C. §103(a) as being obvious over the cited portions of U.S. Patent No. 5,959,874 to Lin et al. (hereinafter "Lin") in view of the cited portions of non-patent literature document "8XC251SB Embedded Microcontroller User's Manual" of Intel Inc. (hereinafter "Intel"). Next, the Office Action has rejected claims 8 and 17 under 35 U.S.C. §103(a) as being obvious over Lin in view of Intel and further in view of the cited portions of U.S. Patent No. 3,993,891 to Beck et al. (hereinafter "Beck"). Finally, the Office Action has rejected claims 23-24 under 35 U.S.C. §103(a) as being obvious over Lin in view of Intel and further in view of the cited portions of U.S. Patent No. 6,141,675 to Slavenburg et al. (hereinafter "Slavenburg").

Applicants believe the motive to make these combinations is lacking along with any likelihood of success in making those combinations. Further, many of the dependent claims are not taught or suggested in Lin, contrary to what is set forth by the Office. Reconsideration is respectfully requested.

Motive to Combine Lin and Intel

Applicant only notes in passing that no cite is given for the motivation to combine Lin and Intel. Final Office Action, page 4, first paragraph, last sentence. Because there is no cite, it is unclear to the Applicant where the motivation to combine comes from. The Office is respectfully requested to clarify if Official Notice is the source of this motivation. Should the rejection be maintained and Official Notice is relied upon, an express showing of proof is respectfully requested as set forth in MPEP 2144.03.

Reasonable Likelihood of Success in Combining Lin and Intel

The obviousness test requires a reasonable likelihood of success in making the suggested combination. As understood by the Applicants, the independent claims are combined by using Lin for all elements except use of an immediate value, which relies upon Intel for that

teaching. Picking and choosing features and inserting them in the suggested manner for such complex systems would have little likelihood of success without undue experimentation. To say differently, trivializes the substantial effort required to design and implement these types of systems.

This problem can be demonstrated by trying to combine these references. Lin provides instruction syntax in Fig. 6, where there are two source registers and a destination register. The ADD instruction cited from Intel, adds an immediate value (#data) to an accumulator register (A). It is not clear how an 8-bit immediate value from Intel could be added to the instruction syntax Lin. The space reserved for the source register addresses (SRC1, SRC2) in Lin are only 5 bits. It is not clear how the instruction syntax would be modified to allow such a combination.

Also, the Intel reference is for a 16-bit processor that doesn't provide for a multiple results to be in a destination register. Any immediate teaching of Intel would have to be expanded to provide for this capability and Lin is no help because of the lack of teaching for an immediate value.

Applicants posit that the combination would have no likelihood of success. Microprocessor designs are the most complex and unpredictable digital designs produced today. For example, Intel is purported to have spent 13 years and multiple-billions developing their Itanium microprocessor. Often several iterations or steppings of the design are required before the microprocessor works properly. To take the position that components from various designs can be interchanged so easily simply goes too far. Reconsideration is respectfully requested.

Teachings Missing from the Cited References

The dependent claims, some amended, provide limitations neither taught nor suggested by the cited references. More specifically, claims 4-6, 12, 13, and 15 require further explanation as to why Lin teaches these limitations.

Claim 5 requires the immediate value be signed. The Office takes the position that Lin teaches this limitation. Final Office Action, page 4, second-to-last paragraph. Earlier,

the office action takes the position that Lin doesn't teach an immediate value. It is not clear how Lin could teach signing the immediate value when it doesn't even teach one.

In claim 6, there is a limitation to scaling the immediate value. The Office sets forth the saturation ability of Lin for this proposition. Final Office Action, page 4, last paragraph. Those skilled in the art appreciate that saturation has nothing to do with prescaling.

Claims 4, 12 and 13 are amended to require a number of bits. The carry-in bit is cited by the Office as the positive integer. The claims are refined to require multiple bits.

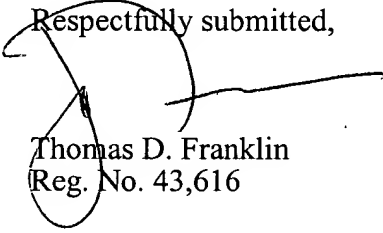
In claim 15, the scaling factor is required to be divisible by two. Lin doesn't teach or suggest scaling as set forth above in relation to claim 6. The Office takes the position that saturation is scaling, which is simply not true. Final Office Action, page 6, last paragraph.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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